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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/884,879	06/19/2001	Carlo Effenhauser	RDID 0061 US	1730
32842	7590	01/12/2004	EXAMINER	
THE LAW OFFICE OF JILL L. WOODBURN, L.L.C. JILL L. WOODBURN 128 SHORE DR. OGDEN DUNES, IN 46368			FORTUNA, ANA M	
			ART UNIT	PAPER NUMBER
			1723	

DATE MAILED: 01/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/884,879

Applicant(s)

EFFENHAUSER ET AL.

Examiner

Ana M Fortuna

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-432 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 17-21, 23, 24 and 26-32 is/are rejected.
- 7) ☒ Claim(s) 8-16, 22, 25 and 33-43 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8/13/01.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. Claims 17-18, 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 17 is unclear as to what is intended. The position of the microdialysis membrane is not understood. The term "past with the transport with the transport liquid or a working liquid is transported by the pump" do not indicated the connection or arrangement between the membrane/sorbent arrangements. Claim 21 is unclear as to the pump system arrangement, the system structure is defined, and the system is claimed base on "the fluid system" and the pump of claim 1. the claim is indefinite as to the elements of the fluid system, which need to be connected to the reservoir and the pump.(of claim 1).
2. Claims 19-20 recites the limitation "body fluids" in lines 2 and 3 respectively. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 1-7, 19, 23, 24, 26, 27-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fecondini et al (5,045,207)(hereinafter '207). Reference '207 substantially teaches the structure claimed in claim 1, including a chamber, to which a solution enters, and a membrane , which is hydrophilic (column 6, lines 29-68), means for introducing the solution into the chamber or channel, and means for drawing solvent through the membrane , e.g. a sorbent contacting the opposite side of the membrane, and contained in a space or chamber opposite to the first membrane layer (column 2, lines 29-68, column 3, lines 1-22). The elements in the structure claimed are identified in Figs 3-4 and 7, elements 8, 11, 7, 9, 18, 19, 20). The apparatus disclosed in '207 is not described as a pump, or as having the space (permeate space) maintained at a constant vapor pressure of the transport liquid, as claimed in the present invention, however, the structural elements seem to compare to each corresponding elements of claims 1, 3, 4, 5, 6, 7. It would have been obvious to one skilled in the art at the time the invention was made, depending on the transport liquid or feed to the conduit or chamber, and on the operating conditions of the apparatus, to consider the apparatus of describe the apparatus as a pump, and/or to obtain a constant vapor pressure at the

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opposite side of the membrane (permeate side), e.g. if the apparatus is used for vapor permeation of a contaminant in a solvent, under perstration conditions, e.g. where the vapor passes through the membrane an is remove by vacuum. Removing the filtrate by vacuum is also disclosed in '207 (column 2, lines 19-22).

Regarding claim 23, the sorbent , and or the membrane covering the total are across the chambers, or housing is shown in the figures, e.g. there is not sorbent and or membrane layers not covered by each other in the described apparatus. As to claim 24, reference '207 discloses disposing a resilient layer between the membrane and the sorbent (element 7), and further also disclose using a supported membrane (column 7, lines 65). Claims 26-33 have been discussed above, as having the same structure of claims 1, 5, 23-24.

Allowable Subject Matter

6. Claims 8-18, 20-22, 25, 33-43 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. The combination of structural elements as claimed in the above claims is not suggested by the prior art of record.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The additional prior art cited in from 892 show devices

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combining membrane adsorbent or sorbent , the membrane in planar or capillary shape, and hydrophilic.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ana M Fortuna whose telephone number is (521) 272-1141. The examiner can normally be reached on 9:30-6:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L. Walker can be reached on (571) 272-1151. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Ana M Fortuna
Primary Examiner
Art Unit 1723

AMF
December 18, 2003